REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-4 and 6-13 are currently pending. No claims have been amended herewith.

In the outstanding Office Action, Claims 1-4, 7-10, and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,727,925 to Bourdelais (hereinafter "the '925 patent") in view of U.S. Patent No. 6,369,835 to Lin (hereinafter "the '835 patent"), further in view of U.S. Patent No. 6,583,792 to Agnew (hereinafter "the '792 patent"); Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the '925,\ '835, and '792 patents, further in view of U.S. Patent No. 5,969,716 to Davis et al. (hereinafter "the '716 patent"); and Claims 11 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '925, '835, and '792 patents, further in view of U.S. Patent No. 5,999,173 to Ubillos (hereinafter "the '173 patent").

Claim 1 is directed to a date-providing apparatus for editing image data in response to a demand transmitted from a data processing apparatus through a network, the data providing apparatus comprising: (1) first acquisition means for acquiring one or more scenarios, each scenario comprising a plurality of scenes and each scene lasting for a predetermined time, in response to a demand made by the data processing apparatus; (2) a second acquisition means for acquiring a predetermined number of image data items that are used in each scenario, in response to a demand made by the data processing apparatus; (3) user video-data management means for storing the one or more scenarios and the image data items; (4) receiving means for receiving image data items transmitted by a user from the data processing apparatus to the network; (5) temporary storage means for temporarily storing edited scenarios and edited image data items; (6) means for selecting the image data items acquired by the second acquisition means and for allocating image data items to scenes of a

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scenario acquired by the first acquisition means; and (7) editing means for editing the image

data items that are received by the receiving means allocated to the scenes of the acquired

scenario.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts

that the '925 patent discloses everything in Claim 1 with the exception of "first acquisition

means for acquiring a scenario consisting of a plurality of means, each lasting for a given

time, in response to a demand made by the data processing apparatus" and "image data items

being transmitted by a user," and relies on the '835 and '792 patents to remedy those

deficiencies.[1]

The '925 patent is directed to a system for designing a room using a browser

connected to a system remote from the browser, in which furnishings are selected for the

room and the furnishings are manipulated by the user. Further, the '925 patent discloses that

the designed room is rendered with substantially photo-realistic perspective images of the

furnishings in a perspective view of the room. For example, as disclosed in column 10 of the

'925 patent, the user of the '925 system can select various colors and styles for the

furnishings. However, Applicants initially note that the '925 patent appears to be directed to

a system to design static images, and not to one or more scenarios, each scenario comprising

a plurality of scenes and each scene lasting for a predetermined time, as recited in Claim 1.

Rather, the '925 patent merely discloses a system for creating individual images or pictures

of a designed room. Further, as admitted in the Office Action, the '925 patent fails to

disclose receiving means for receiving image data items transmitted by a user from a data

processing apparatus through the network, as recited in Claim 1. Further, as admitted in the

Office Action, the '925 patent fails to disclose the first acquisition means for acquiring one or

more scenarios, each scenario comprising a plurality of scenes and each scene lasting for a

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[1] See pages 3 and 4 of the outstanding Office Action.

predetermined period of time, in response to a demand made by the data processing apparatus, as recited in Claim 1. Moreover, Applicants respectfully submit that the '925 patent fails to disclose means for selecting the image data items acquired by the second acquisition means and for <u>allocating the image data items to scenes of a scenario acquired by the first acquisition means</u>, as recited in Claim 1. If, as admitted in the Office Action, the '925 patent fails to disclose the first acquisition means for acquiring the claimed scenes and scenarios, it is unclear to Applicants how the '925 patent can disclose <u>allocating image data items to scenes of a scenario acquired by the first acquisition means</u>. Even if the '835 patent is asserted by the Office Action to disclose the acquiring of scenes, as discussed below, there is no teaching or suggestion in the '925 patent for the '925 patent to allocate image data items to the '835 scenes. In short, the '925 patent does not disclose acquiring scenes of a scenario, and thus certainly would not and does not disclose allocating image data items to such scenes, as required by Claim 1.

The '835 patent is directed to a method and system for generating a movie file from a slide show presentation. The '835 patent discloses that slides in a slide show presentation can be converted into movie data, i.e., audio and video tracks, that can be played back such that the movie is a representation of the slide show presentation. Thus, the '835 patent discloses converting static images (slides) into video objects. However, as admitted in the Office Action, the '835 patent fails to disclose receiving means for receiving <u>image data transmitted by a user</u> from a data processing apparatus through a network, as recited in Claim 1. Moreover, Applicants respectfully submit that the '835 patent fails to disclose means for selecting image data items acquired by the second acquisition means and for <u>allocating the image data items to scenes of a scenario acquired by the first acquisition means</u>, as recited in Claim 1.[2]

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[2] See page 4 of the outstanding Office Action.

The '792 patent is directed to a system and method for accurately displaying superimposed images on a display screen of a computer. As shown in Figure 3, the '792 patent discloses a system in which a user can upload an image of their face and the '792 patent can generated an image of a user wearing particular selected eyewear. However, Applicants respectfully submit that the '792 patent fails to disclose second acquisition means for acquiring a predetermined number of image data items that are used in each scenario, in response to a demand made by the data processing apparatus, as recited in Claim 1. The image uploaded by the '792 system is not used in a scenario, each scenario comprising a plurality of scenes and each scene lasting for a predetermined time, as recited in Claim 1. Rather, the '792 patent is directed to the generation of a static image only. Moreover, Applicants respectfully submit that the '792 patent fails to disclose means for selecting the image data items acquired by the second acquisition means and for allocating the image data items to scenes of a scenario acquired by the first acquisition means, as recited in Claim 1. As discussed above, the '792 patent does not disclose any scenes of a scenario and therefore cannot disclose allocating image data items to scenes of a scenario, as required by Claim 1.

Thus, no matter how the teachings of the '925, '835, and '792 patents are combined, the combination does not teach or suggest second acquisition means for acquiring a predetermined number of image data items that are used in each scenario, and means for selecting the image data items acquired by the second acquisition means and for allocating the image data items to scenes of a scenario acquired by the first acquisition means, as recited in Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 (and dependent Claims 2-4, 7, and 8) should be withdrawn.

In the outstanding Office Action, the stated motivation for combining the teachings of the '925, '835, and '792 patents, is "an order to allow an improved method of editing

multiple media documents" and "so that a user is able to adapt a situation to his/her personal taste by submitting an image to superimpose."[3] However, Applicants respectfully submit that the Office Action is simply stating perceived advantages of Applicants' invention as motivation to combine the references, without identifying that, without Applicants' specification, one of ordinary skill in the art would even have thought to address the problem. Such hindsight reconstruction of Applicants' invention cannot be used to establish a *prima facie* case of obviousness.

Further, Applicant note that the Office Action must show that the motivation for the suggested combination can be found in the prior art. However, the Office Action fails to point to a specific statement in either the '925, '835, or '792 patents that suggests or provides motivation by combining the teachings of these references. The Office Action has also failed to show that the motivation existed in the art, although not in the cited references. *Thus, the Office Action has failed to show factually why one of ordinary skill in the art would have been motivated to select, from all available teachings, the disclosures of the uploaded face image disclosed by the '792 patent and the system for converting a slide show to video disclosed by the '835 patent to be combined with the remote room designing system disclosed by the '925 patent.* The Federal Circuit has held, in In re Sang-Su Lee, that:

> "[t]he factual inquiry whether to combined references must be
> thorough and searching. It must be based on objective
> evidence of record. This precedent has been reinforced in
> myriad decisions, and cannot be dispensed with…The factual
> question of motivation is material to patentability, and cannot
> be resolved on subject belief and unknown authority.[4]

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established since no facts (only unsupported conclusions) have been cited in the record.

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[3] See page 4 of the outstanding Office Action.
[4] In re Sang-Su Lee 277 F.3d 1338 (Fed. Cir. 2002). Emphasis added.

Further, Applicants note that the stated motivation regarding allowing a user to adapt a situation to his/her personal taste by submitting an image to superimpose, is unrelated to the claimed invention. Claim 1 does not recite superimposing images. Moreover, the motivation for combining the '925 and '835, patents, i.e., "in order to allow an improved method of editing multimedia documents," is a general statement that could apply to any patent application in this field of art. Every invention is presumably an improvement over existing methods. Applicants respectfully submit that such a generalized statement cannot be used to establish a *prima facie* case of obviousness. Accordingly, for these additional reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 should be withdrawn.

Independent Claims 9, 10, and 12 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for the reasons stated above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that rejection of Claims 9, 10, and 12 should be withdrawn.

Regarding the rejection of dependent Claims 6, 11, and 13 under 35 U.S.C. § 103, Applicants respectfully submit that the '716 and '173 patents fail to remedy the deficiencies of the '925, '835, and '792 patents. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of dependent Claims 6, 11, and 13 should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 9, 10, and 12 (and all associated dependent claims) patentably define over any proper combination of the cited references.

Consequently, in view of the present amendment and in light of the above discussion,

the outstanding grounds for rejection are believed to have been overcome. The application as

amended herewith is believed to be in condition for formal allowance. An early and

favorable action to that effect is respectfully requested.
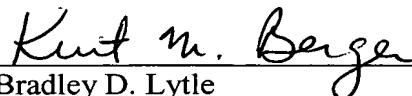
Respectfully submitted,

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